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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/582,351 | 08/11/2000 | TOSHIYUKI NAKAYAMA | 106386 | 3351 |

25944 7590 06/25/2003

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EXAMINER

CHU, CHRIS C

ART UNIT PAPER NUMBER

2815

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/582,351

Applicant(s)

NAKAYAMA, TOSHIYUKI

Examiner

Chris C. Chu

Art Unit

2815

--The MAILING DATE of this c mmunication appears on the cover sheet with the c rresp nd nc address --

THE REPLY FILED 20 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

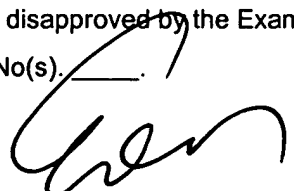
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 - 10, 12 - 19, 21 and 22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


EDDIE LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
Part of Paper No. 25

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues "Replacing the wiring circuit 1a of Maeta, or a portion thereof, with a paddle 36 of Moore would destroy the operation of Maeta, because the monolithic paddle 36 could not perform the same function as the circuit 1a it was replacing." This argument is not persuasive because the only teaching the examiner is relying from Moore is the teaching of the shape of the film (36). Further, since examiner used the shape of the film (36) in Moore into the film (1a) in Maeta and not replacing the film, the modified structure of Maeta is not destroy the operation of Maeta. Further, applicant should notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, Moore clearly discloses in column 2, lines 43 ~ 54 that the saw-tooth shaped of the film (36) of Moore closes the perimeters of inside leads to the film (36) and that close proximity of the film (36) and the inside leads increases the heat dissipation. Thus, since Moore clearly discloses the shape of the film (36) increasing the heat dissipation, the rejection has a case of prima facie obviousness. Even further, Maeta clearly shows that the film (1a) is project outside the region (an area under 1a) in which a microchip would be adhered. Finally, as explained in the above, since Moore discloses the shape of the film (36) increasing the heat dissipation, the one of ordinary skill in the art would have been motivated to combine Tsukagoshi and Moore as suggested by the Office action.